

**REMARKS/ARGUMENTS**

Prior to entry of this amendment, claims 1, 2, 5-22, 25-33 and 36-49 were pending in this application. Claim 22 has been amended, no claims have been added, and no claims have been canceled herein. Therefore, claims 1, 2, 5-22, 25-33 and 36-49 are now pending. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

**Priority**

The Office Action has objected to Applicants' claim for the benefit of the U.S. Provisional applications No. 60/288,087 and 60/285,524. More specifically, the Office Action indicates that "Applicants have not complied with one or more conditions for receiving the benefit of an earlier filing date of the provisional applications . . . because the inventive entity of the provisional [A]pplication No. 60/288,087 and Application No. 60/285,524 is different."

Applicants have filed concurrently herewith a request under 37 C.F.R. 1.48(d) to add Mr. Sajeed Ahmed to the list of inventors for provisional Application No. 60/258,087. A copy of this request is attached hereto as Appendix I for convenience. In summary, Mr. Ahmed was mistakenly omitted from the list of inventors of provisional Application No. 60/258,087 without deceptive intent on the part of Mr. Ahmed, the other inventors, the assignee or the assignee's representatives. Thus, the request to add Mr. Ahmed to the list of inventors of provisional Application No. 60/258,087 has been made.

Furthermore, Applicants respectfully point out that, for an effective claim of priority to a provisional patent application, the inventive entity need not be exactly the same as the Office Action seems to suggest. Rather, a claim of priority can be effective if at least one of the inventors named in the provisional application is also named in the later filed non-provisional application. More specifically, 37 C.F.R. 1.78(a)(4) states in part:

"(4) A nonprovisional application, other than for a design patent, or an international application designating the United States of America may claim an invention disclosed in one or more prior-filed provisional applications. In order for an application to claim the benefit of one or more prior-filed provisional applications, each prior-filed provisional application must name as an inventor **at least one** inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112." (emphasis added)

Since Mr. Ahmed is named as an inventor in the present application and in provisional Application No. 60/285,524, this prior file provisional application names as an inventor at least one inventor named in the later-filed non-provisional application. Thus, the claim of priority of the present application at least to provisional Application No. 60/285,524 is valid. Furthermore, pending grant of the request under 37 C.F.R. 1.48(d), Mr. Ahmed will be named as an inventor in provisional application No. 60/258,087 and the prior filed provisional application will name at least one inventor named in the later-filed non-provisional application. Thus, upon approval of the request, the claim of priority of the present application to provisional Application No. 60/258,087 will be valid.

### 35 U.S.C. §101 Rejection, Non-statutory matter

The Office Action rejected claims 22, 25-32, 46 and 47 under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory matter, specifically, as directed to an abstract idea. While the Applicants respectfully traverse the rejection for reasons similar to those stated previously regarding prior rejections of the method claims, amendments have been made to claim 22, upon which claims 25-32, 46 and 47 depend for the sake of expediency. These amendments are thought to overcome the reasons for rejection. Therefore, the Applicant's respectfully request entry of the amendment and withdrawal of the rejection.

**35 U.S.C. § 102(e) Rejection, Shandony**

The Office Action has rejected claims 1, 2, 5-22, 25-33 and 36-49 under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,675,261 to Michael J. Shandony (hereinafter “Shandony”).

"A person shall be entitled to a patent unless -  
e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by **another** filed in the United States **before** the invention by the applicant for patent." (emphasis added)

Applicant respectfully submits that Shandony is not in fact prior art, i.e., is not before the invention by the applicant. More specifically, the present application claims priority to U.S. Provisional applications No. 60/288,087 and 60/285,524, the same provisional applications that Shandony claims. Therefore, Shandony does not pre-date the present application and cannot represent a patent granted on an application for patent by another filed in the United States before the invention by the applicant.

Furthermore, Applicant respectfully submits that Shandony in fact represents the prior work of at least Mr. Ahmed and thus is not available as prior art. As noted in MPEP §2136.05:

"The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). The issue turns on what the evidence of record shows as to who invented the subject matter. *In re Whittle*, 454 F.2d 1193, 1195, 172 USPQ 535, 537 (CCPA 1972). In fact, even if applicant's work was publicly disclosed prior to his or her application, applicant's own work may not be used against him or her unless there is a time bar under 35 U.S.C. 102(b). *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). Therefore, when the unclaimed subject matter of a reference is applicant's own invention, applicant may overcome a *prima facie* case based on the patent, U.S. patent application

publication, or international application publication, by showing that the disclosure is a description of applicant's own previous work."

Given the nature of the claims of priority, the disclosures made in Shandony and the present application, the common assignee, and the at least one common inventor, it is clear that Shandony is not "by another." That is, when considering the nature of Shandony and the present application, it should be clear that Shandony represents the prior work of at least Mr. Ahmed and thus is not available for use as prior art under 35 U.S.C. §102(e). Therefore, Applicant respectfully submit that the rejection is improper and should be withdrawn.

**35 U.S.C. § 103(a) Rejection, Madan in view of Pinard**

The Office Action has rejected claims 1, 2, 5, 8-15, 17-22, 25-33 and 36-49 under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,748,374 to Madan et al. (hereinafter "Madan") in view of U. S. Patent No. 5,940,834 to Pinard et al. (hereinafter "Pinard"). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). As will be discussed below, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, the cited references do not teach or suggest, alone or in combination, removing auxiliary classes that are superior to a first auxiliary class.

Madan "is directed to the storage and access of object-oriented entities within a relational database management system." (Col. 1, lines 13-15) More specifically, Madan "is directed to the representation and storage of directory information objects, such as LDAP

directory data, in a relational database system" and "the generation of a database query language statement to query or manipulate directory information objects in a relational database." (Col. 4, lines 30-32 and 33-35) Madan discloses methods for defining, modifying, and deleting attribute types (Col. 13, line 16 - col. 14, line 38) and defining, modifying object classes (Col. 14, line 39 - col. 16, line 2). However, Madan explicitly states that "a superior class can not be removed." (Col. 15, lines 34-35)

Pinard relates to "web page generator for automatic generation of web pages in Internet and Intranet environments." (Col. 1, lines 5-7) Under Pinard, a "web page directory is created from data stored in the directory application component of the web page generator and after being placed on a web server, allows any individual who has network access to the web server offering the web page to view the directory information in a web page format." (Col. 1, lines 54-59) That is, Pinard teaches generating a web page to display directory information stored in a database. More specifically, FIG. 2 of Pinard and the accompanying description (col. 4, line 28 - col. 5, line 10) describes "deleting an item class." However, Pinard does not teach or suggest removing auxiliary classes that are superior to a first auxiliary class. Rather, Pinard describes deleting only a selected item or class and is completely silent on removing anything other than the selected class.

The Office Action also argues that the motivation to combine the teachings of Madan and Pinard is "to remove unwanted class of items and the database tables related to that class of items, thereby preventing to removing class to appear on the parent web page." However, such an alleged motivation falls short since Pinard by itself prevents the removed class from being displayed on the web page after the web page is regenerated thus negating any motivation to combine Pinard with another reference to achieve these results. Again, even if combined, the cited portions of Pinard fail to address the shortcomings of the combination of Madan and Pinard. Namely, neither reference, alone or in combination, teaches or suggests removing auxiliary classes that are superior to a first auxiliary class.

Claim 1, upon which claims 2, 5-21, 44, and 45 depend, claim 22, upon which claims 25-32, 46, and 47 depend, and claim 33, upon which claims 36-43, 48, and 49 depend,

each recite in part "removing a subset of said first set of attributes from said entry after said step of creating said first entry wherein removing the subset of said first set of attributes comprises removing a first auxiliary class of one or more auxiliary classes associated with said subset of said first set of attributes and removing auxiliary classes that are superior to said first auxiliary class and that are not superior to any auxiliary classes that remain part of said entry." Neither Madan nor Pinard, alone or in combination, teaches or suggests removing auxiliary classes that are superior to a first auxiliary class. Rather, Pinard teaches removing only a selected item and is completely silent on removing superior items or classes while Madan explicit states that "a superior class can not be removed." For at least these reasons, claims 1, 2, 5, 8-15 and 17-22, 25-33, and 36-49 should be allowed.

Furthermore, the defendant claims are thought to be allowable for additional reasons. For example, claims 44, 46, and 48 each recite in part "iteratively removing classes that are superior to said first auxiliary class and that are not superior to any other classes that remain part of said entry." Claims 45, 47, and 49 further recite "iteratively removing classes that are superior to said first auxiliary class and that are not superior to any other classes that remain part of said entry continues to a root class." As discussed above, none of the references, alone or in combination, teach or suggest removing superior classes. Therefore, none of the reference can teach or suggest iteratively removing superior classes or continuing to remove superior classes to a root class. For at least these additional reasons, claims 44-49 should also be allowed.

**35 U.S.C. § 103(a) Rejection, Madan in view of Pinard and further in view of Desgranges**

The Office Action has rejected claims 6, 7 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Madan in view of Pinard and further in view of U. S. Patent No. 6,751,797 to Desgranges et al. (hereinafter "Desgranges"). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. More specifically, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, the cited references do not teach or suggest, alone or in combination, removing auxiliary classes that are superior to a first auxiliary class. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

As discussed above, the combination of Madan and Pinard does not teach or suggest removing auxiliary classes that are superior to a first auxiliary class. Rather, Pinard teaches removing only a selected item and is completely silent on removing superior items or classes while Madan explicit states that "a superior class can not be removed."

Desgranges is directed to "a method for managing the persistence of EJB [Enterprise Java Beans] components integrated into an EJB server of a computer system. (Col. 1, lines 45-47) The method "consists of managing persistence in a directory accessed via LDAP by mapping and adapting an entity EJB component to a given type of LDAP entry in a given directory." (Col. 1, lines 48-51) Desgranges discloses methods for creating, modifying and deleting these LDAP enties but does not teach or suggest removing auxiliary classes that are superior to a first auxiliary class.

Therefore, none of the references, alone or in combination, teach or suggest removing auxiliary classes that are superior to a first auxiliary class. For at least these reasons, claims 6, 7 and 16 should be allowed.

### **CONCLUSION**

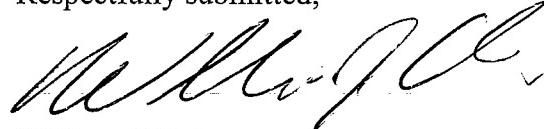
In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

Application No. 09/997,409  
Amendment dated: February 20, 2007  
Reply to Office Action of October 20, 2006

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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Attachments: Petition to Extend Time  
Appendix I

WJD/sbm

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## **APPENDIX I**